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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/694,136	10/23/2000	Herbert M. Straub	20003	9008
28133	7590	01/24/2006	EXAMINER	
RICHARD L. MARSH 4116 E. LATOKA SPRINGFIELD, MO 65809			FERGUSON, LAWRENCE D	
			ART UNIT	PAPER NUMBER
			1774	

DATE MAILED: 01/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/694,136

Applicant(s)

STRAUB ET AL.

Examiner

Lawrence D. Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15,17,18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15,17,18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. This action is in response to the amendment mailed July 24, 2004. Examiner regrets the untimely reopening of the case and withdraws the previous rejections to further prosecute the claimed invention. Claims 1-15, 17-18 and 20 are pending in this case.

Claim Rejections – 35 USC § 102(b)

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-4, 6-7, 11-15, 18 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsukioka (U.S. 5,733,638).

Tsukioka discloses a hot stamped material comprising a base and inner release layer, which are laminated to the base for coating food wrapping materials (column 2, lines 4-7, 28-44) where the laminate includes a film laminated to a paper support and hot stamp printing on the laminate (column 5, lines 62-67). Tsukioka further discloses the sheet is rolled into a foil, which includes a color layer (column 6, lines 26-30 and

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column 7, lines 7-10). The hot stamp material comprising a foil transfers to the substrate by means of an adhesive and may be hot stamped on both sides of the material (column 9, lines 41-67) and the material may be rolled (column 13, lines 38-40).

Tsukioka discloses the substrate is embossed (column 16, lines 20-25).

In instant claims 3-4 and 13-14, the phrase "to be decorated" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform. In claims 1-2, 11-12 and 20, the phrase, "for use in wrapping of a substrate" is intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In claim 20, the phrase, "hot transfer inked foil having a portion of the ink thereon removed prior to being laminated onto a planar paper wrapping film thereby creating a laminated paper wrapping film having portions of the base color of said planar paper wrapping film showing therethrough wherein said carrier is removed from said laminated paper wrapping film and said laminated paper wrapping film is wound upon a roll for use in wrapping a substrate" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art,

the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

Claim Rejections – 35 USC § 102(b)

4. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips et al. (U.S. 5,186,787).

Phillips discloses a hot stamp transfer imaged (inked) foil, carried on a releasable carrier, which is hot stamped onto a substrate, such as paper or film (column 1, lines 8-25, 66-68 and column 2, lines 25-37, 47-64) where the composite is wound upon a roll (column 3, lines 20-21) and comprises a multilayer coating (column 3, lines 23-28). The transferred image on the coating(s) function as being translucent and opaque (column 4, lines 44-50) and an adhesive is placed on the back side of the foil (column 1, lines 22-23). In instant claims 3-4, the phrase “to be decorated” constitutes a ‘capable of’ limitation and that such a recitation that an element is ‘capable of’ performing a function is not a positive limitation but only requires the ability to so perform. In claims 1 and 2, the phrase, “for use in wrapping of a substrate” is intended use. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the

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intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In claim 20, the phrase, "hot transfer inked foil having a portion of the ink thereon removed prior to being laminated onto a planar paper wrapping film thereby creating a laminated paper wrapping film having portions of the base color of said planar paper wrapping film showing therethrough wherein said carrier is removed from said laminated paper wrapping film and said laminated paper wrapping film is wound upon a roll for use in wrapping a substrate" introduces a process limitation to the product claim. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966. Further, process limitations are given no patentable weight in product claims.

Claim Rejections – 35 USC § 103(a)

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 11-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Phillips et al. (U.S. 5,186,787) in view of Boswell (U.S. 5,783,017).

Phillips is relied upon for instant claim 1. Phillips does not disclose an embossed wrapping paper. Boswell teaches a hot stamp transfer imaged (inked) foil, which is hot stamped onto a substrate, such as paper or film, which has adhesive on the back side of the film (column 1, lines 10-21) and an embossed image. Phillips and Boswell are both directed to hot stamp transfer foils. Therefore, it would have been obvious to one of ordinary skill in the art to have employed the embossed surface, as taught in Boswell, in the decorative film of Phillips to improve the texture and appearance of the decorative film. In instant claims 13-14, the phrase "to be decorated" constitutes a 'capable of' limitation and that such a recitation that an element is 'capable of' performing a function is not a positive limitation but only requires the ability to so perform.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Tsukioka (U.S. 5,643,667) teaches a hot stamped material comprising a base and inner release layer, which are laminated to the base for coating food wrapping materials where the laminate includes a film laminated to a paper support and hot stamp printing on the laminate (column 1, line 66 through column 2, line 31).

Response to Arguments

8. Rejection based on 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is withdrawn due to Applicant clarifying the claim language.

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Applicant's arguments of rejection made under 35 U.S.C. 103(a) as being unpatentable over Kotin (U.S. 5,996,672) in view of Salgado et al. (U.S. 6,361,839) are moot based on grounds of new rejection.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye, can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



L. Ferguson
Patent Examiner
AU 1774



RENA DYE
SUPERVISORY PATENT EXAMINER

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